

REMARKS

Claims 1 and 3-21 are currently pending. Claims 1 and 3 are amended. Claim 4 has been withdrawn. Claims 7 and 17 are canceled, and Claim 2 was previously canceled. Applicant respectfully requests reexamination and reconsideration of the pending claims in view of the following remarks.

Claim Rejections – 35 U.S.C. § 112

The Examiner rejected Claims 7 and 17 under 35 U.S.C. § 112, first paragraph, because the claims include subject matter which was not described in the specification.

Applicant has canceled Claims 7 and 17 to advance prosecution and does not admit that the subject matter of Claims 7 and 17 was not disclosed in the specification. Accordingly, Applicant respectfully requests that the Examiner withdraw this rejection.

Double Patenting

The Examiner rejected Claims 1-3 and 5-21 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-4 of U.S. Patent No. 7,186,986.

As noted in M.P.E.P. § 804 (II)(B)(1):

A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); and *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is - does any claim in the application define an invention that is anticipated by, or is merely an obvious variation of an invention claimed in the patent? If the answer is yes, then an "obviousness-type" nonstatutory double patenting rejection may be appropriate. **Obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent, or a non-commonly owned patent but subject to a joint research agreement as set forth in 35 U.S.C. § 103(c)(2) and (3),** when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. See *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 58 USPQ2d 1869 (Fed. Cir. 2001); *Ex parte Davis*, 56 USPQ2d 1434, 1435-36 (Bd. Pat. App. & Inter. 2000).

(emphasis added)

The emphasized portion of the above section requires that the present application (1) be commonly assigned/owned with the owner of U.S. Patent No. 7,186,986 or (2) be subject to a joint research agreement as set forth in 35 U.S.C. § 103(c)(2) and (3) pursuant to the CREATE Act.

As previously stated, Applicant asserts that this double patenting rejection is improper because the present application is not commonly assigned/owned with the owner of U.S. Patent No. 7,186,986, nor is the present application subject to a joint research agreement pursuant to the CREATE Act. Accordingly, Applicant respectfully requests the Examiner to withdraw this rejection.

The Examiner indicates on page 6 of the present Office action:

With respect to applicant's argument, on page 12 of the remarks that the nonstatutory obviousness-type double patenting rejection is improper, it is noted that "double patenting may exist between an issued patent and an application filed by the same inventive entity, or by an inventive entity having a common inventor with the patent, and/or by the owner of the patent" (35 U.S.C. 121). There is at least one common inventor, Thomas R. Mackie, between the issued patent, identified above, and the present application, thus, the rejection set forth above is proper.

Applicant does not find the quoted language identified in the Examiner's comments (restated above) in 35 U.S.C. § 121. Rather, 35 U.S.C. § 121 states the following:

If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Director may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Director to require the application to be restricted to one invention.

Claim Rejections – 35 U.S.C. § 103

The Examiner rejected Claims 1, 3, and 5-21 under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 7,186,986 ("Hinderer").

Hinderer does not disclose the subject matter of amended independent Claim 1. More specifically, Hinderer does not disclose an imaging system including a detector assembly positioned to receive the radiation, the detector assembly including a plurality of substantially planar sheets oriented to extend substantially along the propagation axis and spaced transversely across the axis to define a plurality of axially extending detector volumes; and detection means detecting negatively and positively charged high-energetic particles liberated into the detector volumes to provide for substantially independent signals, wherein the detection means includes amorphous selenium.

The Examiner indicates in the present Office action:

With respect to claims 1, 3, 5, 6, 10, 11, 15, 16 and 18, although Hinderer et al lack a clear inclusion of amorphous selenium material for the detector structure of a plurality of sheets, but amorphous selenium material has been included in another alternative embodiment of tube and wire detecting structure. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hinderer et al by including amorphous selenium material in the detector volume of the detector structure of plurality sheets in order to provide a desired alternative detecting performance for the system.

Applicant respectfully disagrees. Hinderer discloses vastly different embodiments. The first embodiment of Hinderer, illustrated in Figs. 3-6, utilizes tungsten plates that convert photons to electrons and act as a signal collector. The conversion of the photons to electrons must occur in the tungsten plates. The electrons then enter the inert gas (no photon conversion occurs in gas) and interact with the gas molecules to produce a cascade of lower energy electrons. There is no mention of utilizing amorphous selenium with this particular embodiment.

The second embodiment of Hinderer, illustrated in Figs. 9-10, utilizes a set of longitudinally aligned tubes 72 having coaxial wires 74. The space between the wire 74 and the

tube 72 may be filled according to Hinderer with a semi-conductor material such as amorphous selenium 76 so as to produce hole-electron pairs which may be collected by the electrodes formed by the wire 74 and tube 72.

It would not have been obvious to take the amorphous selenium from the second embodiment and add it to the first embodiment of Hinderer. First, if amorphous selenium could have been used with the first embodiment, the inventors would have mentioned it in the specification. Instead, the inventors disclosed a second and distinct embodiment from the first embodiment and mentioned the possibility of using amorphous selenium.

In addition, the detector of the second embodiment, which may include amorphous selenium operates significantly different than the detector of the first embodiment of Hinderer. In operation, the amorphous selenium of the second embodiment does the conversion of photons to electrons and is the charge generator. The conversion occurs within the amorphous selenium layer, and the signal is collected by the electrode formed by the tube and wire. The specified structure of the first embodiment is not conducive to utilizing amorphous selenium.

For at least these reasons, Hinderer does not teach or suggest the subject matter of Claim 1. Accordingly, independent Claim 1 is allowable. Claims 5-14 depend from Claim 1, and are allowable for at least the reason Claim 1 is allowable.

Claims 3 and 15-21 are allowable for at least the reasons discussed above with respect to Claim 1.

CONCLUSION

In view of the foregoing, entry of this Amendment and allowance of Claims 1 and 3-21 are respectfully requested. The undersigned is available for telephone consultation during normal business hours.

Respectfully submitted,

/julie a. haut/

Julie A. Haut
Reg. No. 51,789

Docket No. 013869-9004-01
Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Suite 3300
Milwaukee, Wisconsin 53202-4108
(414) 271-6560